UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/347,780	11/30/94	BARTLEY	T A290C

EXAMINER
SPECTOR, L

18M1/0530

ART UNIT	PAPER NUMBER
1812	11

AMGEN INC
US PATENT OPERATIONS/RRC
M/S 10-2-E-431 AMGEN CENTER
1840 DEHAVILLAND DRIVE
THOUSAND OAKS CA 91320-1789

DATE MAILED: 05/30/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☒ Responsive to communication filed on 2/16/96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 67-77 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-66 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 67-77 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-12 and 28-30, drawn to MGDF polypeptides and corresponding composition, classified in Classes 530 and 424, subclasses 351 and 82.2 respectively

II. Claims 13-24, drawn to polynucleotides that encode the MGDF polypeptides, vectors, cells and method of production of the protein, classified in Classes 435 and 536, subclass 69.5+ and 23.5 respectively.

III. Claims 25-27 to antibodies, classified in Class 530, subclass 388.1+.

VI. Claims 31-35, drawn to related methods of using the MGDF polypeptides, classified in Class 514, subclass 2+.

V. Claims 36-44 and 57-66, drawn to modified/derivative forms of the MGDF polypeptides irrespective of the manner in which they are made, and their corresponding compositions, classified in Classes 530 and 424 subclasses 402+ and 85.2 respectively.

VI. Claims 45-56, drawn to methods of making the modified/derivative forms of the MGDF polypeptides, classified in Class 530, subclass 402+.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the polypeptides can be made by a materially different process such as by the isolation and purification from nature using various isolation and purification protocols; or it

could be produced synthetically. Furthermore, the protein and nucleic acid represent physically, functionally and patentably distinct products, which are not required one for the other.

Inventions of Group V and Group VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the modifies/derivative forms of the MGDF polypeptides can be made using different methods of chemical synthesis and chemical conjugation.

Inventions of Group I and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the polypeptides can be used in various therapeutic methods as shown by the claims or others therapeutic methods; and can be used in various diagnostic methods such as the use as a probe, in immunoaffinity purification, or bio-assays.

The inventions of Groups I, II, III and V are directed to distinct products. Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for different products, restriction is deemed to be proper because these products constitute physically, functionally, and patentably distinct products, which are not required one for the other. Furthermore, the two different methods of Groups IV and VI do not require one another or the products of several of the others Groups; and these methods require the use of physically

and functionally distinct elements, components and steps.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter; the searches are not co-extensive; and there are different issues for the search and examination of each of the Groups, which would be unduly burdensome, therefore, restriction for examination purposes as indicated is proper.

3. A telephone call was made to Robert Cook from Elizabeth Kemmerer 11-30-95 to request an oral election to the above restriction requirement, but did not result in an election being made. **Furthermore, applicants requested a written restriction requirement.**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exm. Lorraine Spector whose telephone number is (703) 308-1793.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Note: Claim 14 is an improper multiple dependent claim which should be corrected.

GARNETTE D. DRAPER
SUPERVISORY PRIMARY EXAMINER
GROUP 1800